

REMARKS

Claims 1-3, 9-11, and 15-20 are now pending in the present application. Claims 4-7 were previously withdrawn. Claims 8 and 12-14 were previously cancelled. This reply is being made in response to the Final Office Action, the Applicant initiated interview with Examiner on May 3, 2007 and Examiner's phone call to Applicant's attorney on May 23, 2007.

On May 3, 2007 at approximately 1000, Examiner conducted a telephonic interview with Steven H. Washam (Prosecuting Attorney, Registration No. 58,266) to discuss the Final Office Action dated March 13, 2007. In that Final Office Action, Examiner continued to reject all claims as anticipated by DE-1160319 (DE'319). The exhibits shown consisted of the Final Office Action (dated March 13, 2007) and Applicant's Reply to Office Action (dated February 8, 2007). No demonstrations were conducted.

The interview centered on the language of independent claim 1. Examiner considered the following claim 1 element:

“... a fluid flow path formed around the periphery of the circumferential wall such that the fluid flow path is external to the defined cavity. . .”

to be anticipated by DE'319. It was demonstrated that the Examiner's “defined cavity” (as noted in the Examiner's drawing from DE'319 on page 3 of the Final Office Action) incorrectly defined the “cavity” of the claimed invention. Annotations made by Examiner on the drawing included a moveable brake disc (12) as one “end wall.” The end wall is more properly defined by element 16 due to the void space between element 16 and the brake disc (12) that forms part of the true cavity of the claimed invention. Because the brake disc (12) features an annular cooling jacket, DE'319 has a portion of its fluid flow path *within* the defined cavity.

An agreement was reached that Examiner would submit an Examiner's Amendment to amend the claim 1 element to read:

“... a fluid flow path formed ~~around the periphery of~~ within the circumferential wall such that the fluid flow path is external to the defined cavity. . .”

to remove any ambiguity. Also, claims 4 through 7 were withdrawn previously during

prosecution. It was further agreed that these withdrawn claims would be cancelled.

In summary, Applicant understands that Examiner, as a result of her interview, has agreed to:

- (1) file an Examiner's Amendment amending the claim 1 language as previously shown;
- (2) cancel withdrawn claims 4 through 7; and

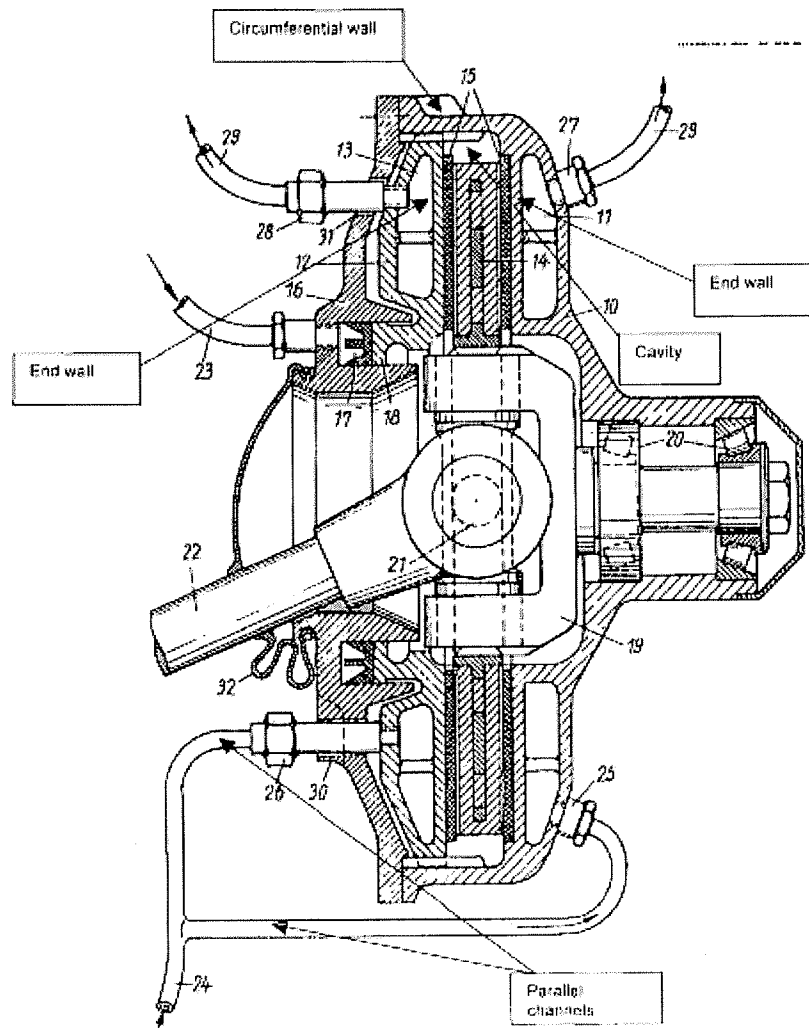
allow the patent to issue with Examiner amended claim 1, and claims 2, 3, 9-11, and 15-20 as previously presented.

However, on May 23, 2007 at approximately 1430 Examiner phoned Prosecuting Attorney to inform him that she would no longer allow the claims as agreed in the previous interview due to a newly discovered reference. Instead, Examiner instructed Prosecuting Attorney to submit a reply to the March 13, 2007 with no amendments but featuring the argument she conceded to during the first interview. Upon receiving the reply, Examiner agreed to withdraw the finality of the office action and issue a new office action citing the newly discovered reference. This reply is presented in response to Examiner's instructions and to satisfy the requirements of 37 C.F.R. § 1.116.

CLAIM REJECTIONS – 35 U.S.C. §102

Examiner rejected Claims 1-3, 11, 15-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by DE-1160319 (DE'319). Specifically, Examiner stated:

Re: claims 1-3, 15, 16, and 20. DE'319 shows in the figure a fluid cooled brake housing 10 for a brake system that includes friction pads 15 and a rotatable element 14 to be braked, the brake housing comprising a circumferential wall as labeled and two axial end walls as labeled that define a cavity as labeled for housing the friction pads and rotatable element, an opening in the at least one of the axial end walls shown surrounding element 19 through which a portion of the rotatable element can extend, a fluid flow path 13 formed around the periphery (the inner periphery) of the circumferential wall such that the fluid flow path is external to the defined cavity as shown, a fluid inlet 24 in fluid communication with the fluid flow path, a fluid outlet 29 in fluid communication with the fluid flow path, a supply of cooling fluid connected to element 24 in fluid communication with the fluid inlet and the fluid outlet, the cooling fluid flowing from the fluid inlet through the fluid flow path to the fluid outlet thereby cooling the entire brake housing, and a seal means 17, 32 for sealing the opening such that the cavity can be at least partially filled with a volume of lubricating fluid 23 to provide a wet brake housing.



Re: claim 11. DE'319 shows the housing comprising a volume of lubricating fluid or fluid surrounding element 19 sealed within the cavity and at least partially covering the rotatable element and the lubricating fluid separate from the cooling fluid by virtue of the structure surrounding element 13.

Re: claim 17. DE'319 shows in the figure the limitation wherein the fluid flow path includes a plurality of parallel channels as labeled in the annotated figure on pg. 3 of the instant Office action extending between the fluid inlet and the fluid outlet.

The claimed invention is distinguishable over DE'319. DE'319 does not teach, either expressly or inherently, each and every element as set forth in the claimed invention. More specifically, DE'319 fails to teach "a fluid flow path formed *around the periphery of the circumferential wall* such that the fluid flow path is *external to the defined cavity*" as provided in Claim 1 (emphasis added).

Examiner asserts that the "cavity" of DE'319, as shown in the above figure, is defined by

the circumferential wall and the two end walls (shown by elements 10 and 12). However, element 12 is, in actuality, a moveable pressure disc with a void space between it and the true end wall, element 16. Because the true cavity of DE'319 is the area defined by elements 10, 16, and the circumferential wall, DE'319 features an annular cooling jacket (13) that is *within* the defined cavity – not outside as is claimed in the present invention. Moreover, if the pressure disc (12) were used to define the cavity, the cavity space would be constantly changing. This is inapposite for the claimed invention.

The cavity of the present invention is defined by the circumferential wall and the two end walls. Each of these walls is fixed. The claim language states that the fluid flow path is formed *around the periphery of the circumferential wall*. Examiner pointed out in her earlier telephonic interview that “periphery” includes the inner and outer surface of the circumferential wall. With this definition, *around the periphery* would include the area in the cavity, making this element vague. However, Applicant asserts that the additional language, “*external to the defined cavity*” restricts the periphery to the surface that is external to the defined cavity. Examiner conceded to this argument in her earlier telephonic interview.

Because DE'319 neither expressly nor inherently teaches this feature, it does not anticipate independent Claim 1 of the claimed invention. Also, DE'319 does not anticipate dependent claims 2, 3, and 9-11 because they incorporate all of the Claim 1 limitations. Applicant respectfully requests that Examiner withdraw this rejection.

CLAIM REJECTIONS – 35 U.S.C. §103

Examiner rejected Claims 9, 10, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE'319 in view of US Patent 5445242 to Pogorzelski et al.

This rejection is respectfully traversed. DE'319 neither teaches nor suggests a fluid flow path around the periphery of the circumferential wall such that it is external to the defined cavity. This limitation is present in both independent Claim 1 and independent Claim 15. Similarly, Pogorzelski et al. neither teaches nor suggests the fluid flow path limitations as well.

It is well established that as a part Examiner's burden to establish a *prima facie* case of obviousness, Examiner is required to show that the referenced teachings “appear to have suggested the claim subject matter.” *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 147 (C.C.P.A. 1976). As stated by the Federal Circuit, “Obviousness cannot be established by

combining teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” *In re Geiger*, 815 F.2d 683, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Neither DE’319 nor Pogorzelski, et al., either alone or in combination, teach or disclose every element of Claim 1 or Claim 15 of Applicant’s invention. Accordingly, claims 9, 10, 18, and 19 are nonobvious because they are dependent claims. Examiner has not established a *prima facie* case of obviousness, and this rejection should be withdrawn.

CONCLUSION

Applicant respectfully urges that the subject application is patentable over references cited by Examiner. Accordingly, and in view of Examiner's May 23, 2007 telephone offer, Applicant requests reconsideration of the application and withdrawal of the finality of the Final Office Action.

If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact David W. Carstens at 972-367-2001. The Commissioner is hereby authorized to charge any shortages or credit any overpayments to Deposit Account 50-0392.

Respectfully submitted,

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